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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,897	11/30/2001	Phillip Yuan Pei Jen	40391/184638	6192
826	7590	09/21/2005		
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER GELAGAY, SHEWAYE	
			ART UNIT	PAPER NUMBER
			2133	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/997,897	PEI JEN, PHILLIP YUAN	
	Examiner	Art Unit	
	Shewaye Gelagay	2133	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/30/01</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-19 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-5, 7-10, 12, 14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matyas et al. (hereinafter Matyas) United States Letter Patent Number 4,757,534 in view of Nerlikar et al. (hereinafter Nerlikar) United States Letter Patent Number 5,905,798.

As per claims 1, 9 and 17:

Matyas teaches a method for protecting against the unauthorized use of software originally installed upon a computer from a medium, comprising:

obtaining a first access-control code from a memory device resident within the computer, wherein the access control code is associated with the computer, a smart card; (Col. 3, lines 31-47; Col. 9, lines 4-8)

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obtaining a second access-control code resident on the smart card, wherein the access control code is associated with the computer, the smart card; (Col. 3, lines 31-47; Col. 9, lines 4-8) and

allowing software to execute when the first access-control code and the second access-control code are the same. (Col. 9, lines 8-10)

In addition, Matyas discloses a unique file key is written on the diskette to provide a software protection scheme. (col. 2, lines 46-48)

Matyas does not explicitly disclose a medium having a radio frequency device.

Nerlikar in analogous art, however, discloses a medium having a radio frequency device for protection of copyrighted program material. (Figure 1, Col. 3, lines 1-19)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Matyas to include a medium having a radio frequency device. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, Nerlikar (Col. 1, lines 11-13) in order use RF-ID systems for securing the intellectual property value of copyrighted material.

As per claims 2 and 18:

The combination of Matyas and Nerlikar discloses all the subject matter discussed above. In addition, Matyas further discloses installing the software on the computer. (Col. 2, lines 33-35)

As per claim 4:

The combination of Matyas and Nerlikar discloses all the subject matter discussed above. In addition, Matyas further discloses wherein installing the software on the computer comprises obtaining the first access control code, obtaining the second access control code, comparing the first and second access control codes, and, if the first and second access control codes are identical, writing the access control code to the medium that embodies the software. (Col. 2, lines 47-48)

As per claims 5 and 14:

Matyas discloses a method for protecting against the unauthorized installation of software resident on a medium, comprising:

obtaining a first access-control code from a memory device resident within a computer; (Col. 3, lines 31-47; Col. 9, lines 4-8)

obtaining a second access-control code resident on a smart card; (Col. 3, lines 31-47; Col. 9, lines 4-8)

comparing the first access-control code and the second access-control code; (Col. 9, lines 8-10) and

allowing installation of the software when the first access-control code and the second access-control code are the same and the medium is without any third access-control code. (Col. 9, lines 8-10)

Matyas does not explicitly disclose obtaining a third access-control code associated with the medium.

Nerlikar in analogous art, however, discloses obtaining a third access-control code associated with the medium. (Figure 1, Col. 3, lines 1-19)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Matyas to include obtaining a third access-control code associated with the medium. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, Nerlikar (Col. 1, lines 11-13) in order use RF-ID systems for securing the intellectual property value of copyrighted material.

As per claim 7:

The combination of Matyas and Nerlikar discloses all the subject matter discussed above. In addition, Matyas further discloses allowing installation of the software when the third access-control code and the second access-control code are the same. (Col. 2, lines 33-35)

As per claims 8 and 10:

The combination of Matyas and Nerlikar discloses all the subject matter discussed above. In addition, Matyas further discloses writing the first access-control code to the memory device resident on the computer when the second access-control code and the third access-control code are the same. (Col. 3, lines 26-28)

As per claim 12:

Matyas discloses a system for protecting against the unauthorized use and unauthorized installation of software, comprising:

a computer having a memory device; (Figure 1, item 10)

a smart card drive communicatively connected to the computer, wherein said smart card includes an access-control code that is capable of being read by said computer from the smart card; (Figure 5, item 16; Col. 2, lines 5-46) and

an optical disc drive communicatively connected to the computer for receiving an optical disc; (Col. 4, line 60-63; Col. 7, lines 66-67; Col. 8, lines 1-2)

Matyas does not explicitly disclose an optical disc having a radio frequency device embodied therein, said optical disc drive comprising a radio frequency drive capable of reading an access-control code from the radio frequency device.

Nerlikar in analogous art, however, discloses an optical disc having a radio frequency device embodied therein, said optical disc drive comprising a radio frequency drive capable of reading an access-control code from the radio frequency device. (Figure 1, Col. 3, lines 1-19)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Matyas to include a medium having a radio frequency device. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, Nerlikar (Col. 1, lines 11-13) in order use RF-ID systems for securing the intellectual property value of copyrighted material.

As per claim 16:

Matyas discloses a computer-readable storage medium encoded with processing instructions for implementing a method for protecting against the unauthorized

installation of software, said processing instructions directing a computer to perform the steps of:

obtaining a first access-control code from a memory device resident within a computer; (Col. 3, lines 31-47; Col. 9, lines 4-8)

obtaining a second access-control code resident on a smart card; (Col. 3, lines 31-47; Col. 9, lines 4-8)

comparing the first access-control code and the second access-control code; (Col. 9, lines 8-10) and

allowing installation of the software when the first access-control code and the second access-control code are the same (Col. 9, lines 8-10)

Matyas does not explicitly disclose obtaining any third access-control code resident on a programmable device that is associated with the medium; and comparing with the third access code and allowing installation if the access-code is the same.

Nerlikar in analogous art, however, discloses obtaining a third access-control code associated with the medium. (Figure 1, Col. 3, lines 1-19) and comparing with the third access code and allowing installation if the access-code is the same (Col. 3, lines 1-19)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Matyas to include obtaining any third access-control code resident on a programmable device that is associated with the medium; and comparing with the third access code and allowing installation if the access-code is the same. This modification would have been obvious

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because a person having ordinary skill in the art would have been motivated to do so, as suggested by, Nerlikar (Col. 1, lines 11-13) in order use RF-ID systems for securing the intellectual property value of copyrighted material.

4. Claims 3, 6, 13, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matyas et al. (hereinafter Matyas) United States Letter Patent Number 4,757,534 in view of Nerlikar et al. (hereinafter Nerlikar) United States Letter Patent Number 5,905,798 and further in view of Purcell et al. (hereinafter Purcell) United States Letter Patent Number 6,227,643.

As per claims 3, 6, 13, 15 and 19:

The combination of Matyas and Nerlikar discloses all the subject matter discussed above. In addition, Matyas further discloses wherein installing the software on the computer comprises obtaining the first access-control code, (Col. 3, lines 31-47; Col. 9, lines 4-8) obtaining the second access-control code, (Col. 3, lines 31-47; Col. 9, lines 4-8) comparing the first and the second access-control codes; (Col. 9, lines 8-10),

Both references do not explicitly disclose writing the access control code to the radio frequency device associated with the medium.

Purcell in analogous art, however, discloses a memory element in the media comprising a writable RF identification tag embedded and an RF transceiver incorporated in the identification tag and writes information about the media use. (Col. 2, lines 12-20)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Matyas and

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Nerlikar to include writing the access control code to the radio frequency device associated with the medium. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so, as suggested by, Nerlikar (Col. 1, lines 11-13) in order use RF-ID systems for securing the intellectual property value of copyrighted material.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matyas et al. (hereinafter Matyas) United States Letter Patent Number 4,757,534 in view of Nerlikar et al. (hereinafter Nerlikar) United States Letter Patent Number 5,905,798 and further in view of Thomas et al. (hereinafter Thomas) United States Letter Patent Number 6,529,992.

The combination of Matyas and Nerlikar discloses all the subject matter discussed above. Both references do not explicitly disclose ejecting the medium if the first access-control code and second access-control code are not the same.

Thomas in analogous art, however, discloses ejecting the medium if the first access-control code and second access-control code are not the same. (Col. 7, lines 60-62; Col. 9, lines 32-33)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the device disclosed by Matyas and Nerlikar to include ejecting the medium if the first access-control code and second access-control code are not the same. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so,

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as suggested by, Thomas (Abstract) in order to automatically execute a participating application upon insertion of a removable media into a computing device.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shewaye Gelagay whose telephone number is 571-272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shewaye Gelagay 

9/16/05


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